REMARKS

Applicant appreciates the telephone interview conducted by Examiner Alford Kindred and Examiner Merilyn Nguyen on January 10, 2007. Todd Van Thomme, Terry Callaghan, and Andrea Zydron participated on behalf of the Applicant. The Applicant and the Examiners primarily discussed various aspects of the invention that is the subject of this application and also specifically discussed the reasons why the Rebane reference is distinguished from the presently claimed invention. The Examiners stated that they would review the specification of the invention to further familiarize themselves with the invention and one of them would contact the Applicant to further discuss the Examiners' position. Examiner Merilyn Nguyen contacted the Applicant and suggested filing the present Response incorporating arguments made in the initial telephone interview.

Initially, Applicant notes it has amended the specification to describe inherently described elements more explicitly as helpfully suggested by the Examiner. Additionally, Applicant has amended the specification, the third paragraph of the Detailed Description, to add disclosure that was originally presented in the application as filed, namely http://www.widgets.com. On May 24, 2004, the Examiner objected to this language citing MPEP § 608.01. In response, on July 14, 2004, Applicant deleted the language. However, upon further evaluation, the MPEP section cited by the Examiner as the basis for objecting to the specification, 608.01, specifically provides in the "Examiner Note" section of paragraph 7.29.04:

> Examiners should not object to hyperlinks where the hyperlinks and/or browser-executable codes themselves (rather than the contents of the site to which the hyperlinks are directed) are necessary to be included in the patent application in order to meet the requirements of 35 U.S.C. 112, first paragraph, and applicant does not intend to have those hyperlinks be active links.

This is the case in the present application, which has been amended to contain hypothetical hyperlinks in the amended paragraph. The described hyperlinks are present for purposes of

35 U.S.C. §112, first paragraph and Applicant does not intend to have the hyperlink be active. Accordingly, Applicant respectfully submits that inclusion of the hyperlink in the specification should not be objectionable.

In Response to the Office Action mailed September 13, 2006, Applicant provides the following Remarks and requests further consideration of the application. In the September 13, 2006, Office Action, the Examiner objected to the abstract because it included the phrase "the present invention includes." Applicant has amended the abstract to remove this phrase. Accordingly, Applicant believes this objection has now been addressed and overcome.

Next, the Examiner rendered a provisional obviousness-type double patenting rejection based on various claims of co-pending Application Serial No. 10/421,268. Pursuant to MPEP §804 paragraph I.B.1., Applicant respectfully traverses this rejection and, if appropriate, likely will file a terminal disclaimer in this case if the relevant claims of Application Serial No. 10/421,268 are allowed or issue prior to the rejected claims in this case. Applicant traverses the rejection since this rejection may be withdrawn if this application is allowed before the claims in Application Serial No. 10/421,268.

The Examiner rejected claims 1, 11, 19, 22, 24, 49, 51, and 53 under 35 U.S.C. §101 because, according to the Examiner, the claimed invention is directed toward non-statutory subject matter. In particular, the Examiner's rejection as specifically applied to the pending claims stated:

> In the present case, claimed invention (claim 1, 11, 51, and 53) only recites an abstract idea and does not product [sic] practical application. The recited limitations only describe the idea of how to identify a supplier of goods or services over the Internet.
>
> In the present case, claimed invention (Claims 1, 11, 19, 22, 24, 36, 49, 51, and 53) does not produce tangible result since it recites an abstract idea, which no physical transformation is involved.

(Office Action mailed September 13, 2006, pg. 5).

In discussing this rejection with the Examiners, Applicant discussed Applicant's belief that the

claims pending satisfied §101 and requested further explanation of this rejection. Examiner Nguyen suggested that the Applicant amend the method claims to separately positively recite the steps already present in claim 1, for example. Additionally, Examiner Nguyen suggested possibly amending the specification and claims to state the inherent fact that the directory Web site is stored on a tangible storage medium connected to a network, *i.e.*, the Internet. Examiner Nguyen suggested that additional terms inherent in the original specification should also be added to the specification as well as explicitly added to the claims when desired. Accordingly, Applicant has amended the specification to explicitly state information inherently present. Applicant respectfully submits it would have been clear to one of ordinary skill that the added material was necessarily present in the original description. Applicant believes the original claims both described practical application of the method for identifying a supplier of goods or services over the Internet and produced a tangible result. Nevertheless, to further the prosecution of this case, Applicant has amended the claims in this case as suggested by the Examiner to address the concerns expressed by the Examiner in this regard. If the rejection is maintained, Applicant respectfully requests that the Examiner provide a more detailed explanation of the rejection based upon §101.

Additionally, the Examiner rejected dependent claims 28, 29, 40, and 41 under 35 U.S.C. §112, second paragraph as being indefinite. In particular, the Examiner expressed concerns about the recitation of "at least partially visible." In the Examiner's opinion, this language rendered the claims vague and indefinite because it did not provide a standard for ascertaining the requisite degree. Applicant has amended these claims to state that a portion of the rollover window is visible, which Applicant respectfully submits does not narrow the scope of the claim. Applicant respectfully submits the claims as amended overcome this rejection

The Examiner rejected claims 1-6, 8-17, 24-34, 36-46, and 48-54 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,662,192 (hereinafter Rebane) in view of U.S. Patent Application Publication No. 2002/0194151 (hereinafter Fenton). The Examiner has the initial burden of proving a *prima facie* case of obviousness (MPEP §2142). In order to establish a *prima facie* case of obviousness under MPEP § 2143, the Examiner must prove:

(1) a suggestion or motivation to modify the reference or combine the reference teachings, (2) a reasonable expectation of success, and (3) the references when combined must teach or suggest all of the claim limitations. Applicant respectfully submits that the Examiner's conclusion of obviousness was based on improper hindsight reasoning since the express motivation to combine the two references was lacking. *See* MPEP § 2145, para. X.A.

Initially, with respect to the claims that claim a rollover window, Applicant respectfully submits that one of ordinary skill in the art would not have combined Rebane with the rollover display box disclosed in Fenton. According to the specification of Rebane, the object of the patent is to evaluate and to compare the performances of businesses engaged in electronic commerce. (*See* Rebane, col. 1, lines 10-12, Fig. 18). With the intention of overcoming the disadvantages of traditional surveying, Rebane teaches a system for gathering evaluation data and presenting these results via the Internet to enable users to rate and compare the business activities of various merchants. (*See* Rebane, col. 4, lines 23-30 and col. 5, lines 5-57, Fig. 18). With respect to all of the claims which require a rollover window, in order to provide users with the greatest number of comparisons, a rollover display box would not be beneficial to use and would be contrary to the purpose of Rebane – to rate and compare businesses – because a rollover window consumes a valuable amount of space on the web site that would thereby limit the number of rated businesses. Since the apparent purpose of the Rebane patent is to display as many merchant comparisons as possible to obtain a more accurate and comprehensive evaluation, Applicant respectfully submits that, with respect to the claims which require a rollover window, one of ordinary skill in the art would not have combined the Fenton rollover display box with the Rebane patent.

Additionally, Applicant respectfully asserts that the Examiner has not met the requirements in order to prove a *prima facie* case of obviousness. In particular, the references do not teach or suggest all of the claimed limitations. With reference to Fig. 18 of Rebane (the '192 patent) and Applicant's amended claims, Fig. 18 of Rebane does not disclose a web site where selecting the supplier link for a supplier who offers goods or services of the class of goods or services defined by a portion of the directory Web site address or where the

supplier's goods or services relate to the defined or selected class of goods or services. Regarding the previously presented claims, the Examiner asserted that Figs. 16, 18, and 20 of Rebane disclose a directory Web site (Bizrate.com) at least partially descriptive of the class of goods or services, arbitrarily assigned "rating suppliers giving best PDA products" by the Examiner, and that Rebane discloses selecting the supplier link for a supplier of goods or services of the class of goods or services. However, the supplier links listed in Fig. 18 are not for a supplier of the class of goods or services of the directory Web site or for a supplier offering the goods or services. Activating the various links listed in Fig. 18, such as "ecost.com," does not activate a supplier Web site that offers the services of "rating suppliers giving best PDA products," but rather presumably these businesses offer PDAs.

Additionally, a majority of the claims have been amended to state that the class of goods or services is selected or defined by a portion of the directory Web site address. Accordingly, Applicant submits that with respect to at least these claims, the supplier links in Fig. 18 would have to be for suppliers of business rating services (bizrate.com) when, in fact, the links in Fig. 18 are suppliers of PDAs.

Moreover, regarding the claims that claim a supplier descriptive portion, the Rebane reference does not disclose a supplier descriptive portion which describes a supplier who offers goods or services of the defined or selected class of goods or services (*see*, for example, claim 5). For example, in Fig. 18 of the Rebane reference, the supplier descriptive portion, 3% rebate according to the Examiner, does not correspond to the class of goods or services suggested by the Examiner, namely rating suppliers giving best PDA products. Additionally, the purported supplier descriptive portion "3% rebate" does not correspond to the class of goods or services (business rating services) defined by a portion of the disclosed Internet address, namely bizrate.com.

Accordingly, for at least the above reasons, Applicant respectfully submits that the presently pending claims are in condition for allowance. If the Examiner has any questions or concerns, the Examiner is kindly requested to contact the undersigned attorney at (616) 949-9610.

Respectfully submitted,

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March 13, 2007
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